

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

9407-5

I hereby certify that this correspondence is being transmitted electronically to the U.S. Patent and Trademark Office

on February 27, 2008

Signature

Joyce Paoli

Typed or printed name

Joyce Paoli

Application Number

10/647,269

Filed

08/22/2003

First Named Inventor

Steven Lingafelt

Art Unit

2154

Examiner

Siddiqui

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

48,441

Registration number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Laura M. Kelley

Signature

Laura M. Kelley

Typed or printed name

919 854 1400

Telephone number

February 27, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒

*Total of 2 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Steven Lingafelt et al.

Examiner: Mohammad A. Siddiqi

Serial No.: 10/647,269

Group Art No.: 2154

Filed: August 22, 2003

Confirmation No.: 2069

For: METHODS, SYSTEMS AND COMPUTER PROGRAM PRODUCTS FOR
PROVIDING STATUS INFORMATION TO A DEVICE ATTACHED TO AN
INFORMATION INFRASTRUCTURE

Date: February 27, 2008

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REASONS IN SUPPORT OF APPLICANTS'
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program.

It is not believed that an extension of time and/or any additional fee(s) are required beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to our Deposit Account No. 50-0629.

REMARKS

Applicants hereby request a Pre-Appeal Brief Review (hereinafter "Request") of Claims 1-23, which stand finally rejected in the Final Office Action of November 27, 2007 (the Final Action). Claims 1, 4, 5, 9-12, 15-17 and 20-21 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,269,649 to Brown et al. ("Brown"). Claims 22-23 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0042886 to Lahti ("Lahti"). Claims 2, 3, 6-8, 13-14 and 18-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over 7,024,548 to O'Toole ("O'Toole"). Applicants respectfully submit that many of the recitations of the claims are not described or suggested by the cited references. One or more elements needed for a *prima*

In re: Steven Lingafelt
Application number: 10/647,269
Filed: August 22, 2003
Page 2 of 5

facie rejection under 35 U.S.C. §§ 102(e)/103(a) are, therefore, simply not present. In the interest of brevity, and without waiving the right to argue additional grounds should this Request be denied, Applicants will point out the Examiner's omissions of one or more essential elements needed for a *prima facie* rejection.

I. Claims 1-21 are Patentable over Brown and O'Toole

Claim 1 recites as follows:

A method of providing status information to a device attached to an information technology infrastructure utilizing a device data monitoring application resident at the device, the device monitoring application utilizing signature data to monitor data associated with the device and selectively provide messages based on a correspondence between signature data and data associated with the device, comprising:

- incorporating a message signature in the signature data;
- monitoring data associated with the device utilizing the device monitoring application so as to detect a presence of the message signature in the monitored data; and
- providing a status message utilizing the device monitoring application if the presence of the message signature is detected in the monitored data, wherein the signature data includes computer virus signatures and the message signature is not related to a computer virus.

According to embodiments of the invention and as discussed, for example, in the specification on page 10, line 5 - 29, the signature data can include an antivirus signature list of computer virus signatures. A message signature is incorporated into the antivirus signature list, and the message signature is not related to a computer virus. Therefore, in some embodiments of the invention, an antivirus system may be used for non-malicious communication, including, *e.g.*, providing a request to register the device in an information technology infrastructure (Claim 6), providing instructions to register the device (Claim 7), and providing an emergency message (Claim 8).

The Action apparently takes the position that the extended signature 400 of Brown is analogous to incorporating a message signature in the signature data. *See* the Action, page 3. However, all portions of the extended signature 400 of Brown appear related to a computer

In re: Steven Lingafelt
Application number: 10/647,269
Filed: August 22, 2003
Page 3 of 5

virus. In particular, the extended signature 400 of Brown includes a file component 402, a memory component 404, and a stream component 406. The file component 402 and the memory component 404 are simply components of typical virus signatures as discussed in Brown, col. 1, lines 58-62. The file component 402 is used to scan a file system, and the memory component 404 is used to scan the memory of the target device for viruses. Brown merely adds a new stream component 406 that is used to analyze streaming data entering or exiting a device or network that includes a port signature. The port signature indicates ports that a known instance of malicious code (*i.e.*, a virus) attempts to access. *See* col. 4, lines 60-65. For example, in the case of a Trojan, the ports that a particular Trojan is known to attempt to access are listed. *See* col. 4, lines 66-67.

Accordingly, Applicants submit that all portions of the extended signature 400 of Brown (which the Action identifies as analogous to the signature data recited in Claim 1) are related to a computer virus. The file component 402, the memory component 404, and the stream component 406 are all used to analyze/scan information on a device for indications of a virus. In contrast, Claim 1 recites “incorporating a message signature in the signature data” and that the “message signature is not related to a computer virus.”

These features are also not disclosed or rendered obvious by O’Toole, which proposes a change controller application that tracks modifications to a configuration of a computerized device by receiving a change request and preparing a change notification. *See* O’Toole, Abstract.

For at least these reasons, Applicants submit that the recitations of Claim 1 are patentable over the cited art. Independent Claims 12 and 17 include recitations analogous to those discussed above with respect to Claim 1. Accordingly, Applicants submit that independent Claims 1, 12 and 17 and Claims 2-11, 13-16 and 18-21 depending therefrom are patentable over the cited art and request that the rejections under Sections 102/103 be reversed.

II. Claims 22-23 are Patentable over Lahti

Claim 22 recites as follows:

A method of communicating registration information to an unregistered device in the information technology infrastructure comprising:

using antivirus software to communicate a request for device registration and/or instructions regarding how to register a device to an unregistered device in the information technology infrastructure.

Lahti discusses a method of protecting a wireless device against viruses by maintaining a database of virus signatures on the device, updating the database by downloading virus signatures in a Short Message Service (SMS) message, and searching for virus signatures in the memory of or files stored on the wireless device by comparison with the database. *See* Abstract.

Applicants submit that Lahti does not appear to even discuss device registration in an information technology infrastructure. In fact, Lahti appears to only discuss techniques that involve subscribers, who are registered users. Therefore, Lahti does not disclose communicating with an unregistered device, *i.e.*, using antivirus software to communicate a request for device registration and/or instructions regarding how to register a device to an unregistered device in an information technology infrastructure as recited in Claim 22.

In particular, the portions of Lahti cited in the Action discuss sending SMS updates automatically from the network to subscribers or as triggered by requests from subscribers. *See* paragraphs 24-25. Lahti further states that the SMS server 12 maintains a record of all subscribers to the anti-virus software in a database 13, and "initiates virus signature database updates by sending a Short Message Service (SMS) request for each of the registered subscribers..." *See* paragraph 23 (emphasis added). Accordingly, the SMS server 12 apparently communicates virus database updates only to registered subscribers. Applicants cannot locate any portion of Lahti that relates to unregistered users or communicates any information to devices that are not part of the record of registered subscribers discussed in paragraph 23. Therefore, Lahti does not disclose using antivirus software to communicate a request for device registration and/or instructions regarding how to register a device to an

In re: Steven Lingafelt
Application number: 10/647,269
Filed: August 22, 2003
Page 5 of 5

unregistered device in the information technology infrastructure as recited in Claim 22.

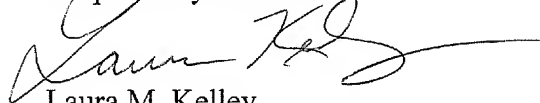
In addition, Applicants submit that there are no apparent reasons to modify Lahti to communicate a request for device registration and/or instructions regarding how to register a device to an unregistered device in the information technology infrastructure as recited in Claim 22 because Lahti appears to communicate virus database updates only to registered subscribers.

For at least these reasons, Applicants submit that the recitations of Claim 22 and Claim 23 depending therefrom are patentable over the cited art. Accordingly, Applicants request that the rejections under Section 102 be reversed.

III. Conclusion

Accordingly, for at least the reasons discussed above, the recitations of the independent claims are not described by the references cited in the Action so that one or more elements needed for a *prima facie* rejection under 35 U.S.C. §§ 102(e)/103(a) are not present. Therefore, Applicants respectfully request Pre-Appeal Brief Review of the present application and that the rejections be reversed by the Pre-Appeal Brief Review Panel prior to the filing of an Appeal Brief.

Respectfully submitted,

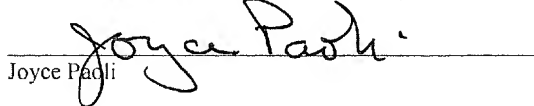


Laura M. Kelley
Attorney For Applicants
Registration No. 48,441

USPTO Customer No. 20792
Myers Bigel Sibley & Sajovec
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: 919/854-1400
Facsimile: 919/854-1401

Certificate of Electronic Transmission 37 CFR 1.8

I hereby certify that this correspondence is being filed electronically to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 27, 2008.



Joyce Paoli